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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/404,772 | 09/24/1999 | RANDALL A. HAVNER | 99SW087 | 8769 |

7590

04/28/2004

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EXAMINER

NAHAR, QAMRUN

| ART UNIT | PAPER NUMBER |
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2124

12

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | | |
|------------------------------|-------------------------------|-------------------------------|--|
| Office Action Summary | Application No. 09/404,772 | Applicant(s) HAVNER ET AL. | |
| | Examiner Qamrun Nahar | Art Unit 2124 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-21 and 28-31 is/are allowed.
- 6) ☒ Claim(s) 22 and 25-27 is/are rejected.
- 7) ☒ Claim(s) 23-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. <u>11</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. This action is in response to the RCE filed on 3/30/04.
2. The rejection under 35 U.S.C. 102(b) as being anticipated by Lewis (U.S. 5,812,394) to claims 1-21 and 23-30 is withdrawn in view of applicant's arguments and in view of new ground(s) of rejection.
3. The amendments filed on 2/27/04 and 3/30/04 have been entered.
4. Claim 31 is added.
5. Claim 10 has been amended.
6. Claims 1-31 are pending.
7. Claims 1-21 and 28-31 are allowed.
8. Claims 23-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Claims 25-27 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of prior U.S. Patent No. 6,477,435 to Ryan et al. This is a double patenting rejection.
10. Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Lewis (U.S. 5,812,394).

Double Patenting

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v.*

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Eagle Mfg. Co., 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claims 25-27 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of prior U.S. Patent No. 6,477,435 to Ryan et al. This is a double patenting rejection.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Lewis (U.S. 5,812,394).

Per Claim 22:

The Lewis patent discloses:

- a method of creating a program (column 11, lines 58-63 and column 12, lines 13-16)

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- **providing a library storing a plurality of program fragments respectively within a plurality of library subportions, wherein at least some of the library subportions include a program fragment of a first type and a program fragment of a second type** (column 18, lines 26-39; column 27, lines 44-67 to column 28, lines 1-8; device objects are interpreted as a first type and device symbols are interpreted as a second type)

- **receiving commands to link instances of the program fragments of the first type with one another to form a control program; instantiating the program fragments of the first type about which the commands were received, wherein the instantiating includes modifying variables of those program fragments** (column 12, lines 52-60 and column 28, lines 26-46)

- **and identifying program fragments of the second type corresponding to the instantiated program fragments of the first type based upon the library subportions within which the program fragments are stored** (column 12, lines 36-52 and column 28, lines 31-46).

Allowable Subject Matter

15. Claims 23-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. The following is a statement of reasons for the indication of allowable subject matter:

The cited prior art taken alone or in combination fail to teach, in combination with the other claimed limitations, a first program builder accepting user input to link in a first linking process instances of first program fragments from files in the library manager together to create a first portion of the control program and a second program builder accepting information about the first linking process, and user input, to create a second portion of the control program from second program fragments taken from the same files of the first program fragments used in the first portion of the control program as substantially recited in independent claims 1, 16, 19, 28 and 31.

The closest cited prior art, Lewis (U.S. 5,812,394) discloses a method and system of creating a control program, where a template, including logic and symbol, is created/instantiated in one step/stage creation. However, Lewis (U.S. 5,812,394) fails to teach two stage creation, where a first program builder accepting user input to link in a first linking process instances of first program fragments from files in the library manager together to create a first portion of the control program and a second program builder accepting information about the first linking process, and user input, to create a second portion of the control program from second program fragments taken from the same files of the first program fragments used in the first portion of the control program as substantially recited in independent claims 1, 16, 19, 28 and 31.

Conclusion

17. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (703) 305-7699. The examiner can normally be

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reached on Mondays through Thursdays from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki, can be reached on (703) 305-9662. The fax phone number for the organization where this application or processing is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

QN
April 21, 2004



TODD INBERG
PRIMARY EXAMINER